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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,508	01/30/2004	Bruce Michael Luzzi	1812	6886
27310	7590	11/18/2004	EXAMINER	
PIONEER HI-BRED INTERNATIONAL INC. 7100 N.W. 62ND AVENUE P.O. BOX 1000 JOHNSTON, IA 50131				KRUSE, DAVID H
ART UNIT		PAPER NUMBER		
1638				

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/768,508	LUZZI ET AL.	
	<b>Examiner</b> David H Kruse	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: ____ .   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/30/2004</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed 30 April 2004 has been considered.

Those references cited under "U.S. Patent Applications" will not be printed on the face of the patent as requested by Applicant.

### *Specification*

2. The Abstract is objected to as not being commensurate with the scope of the claimed invention. Appropriate correction is required. See MPEP § 608.01(b).
3. On page 39, line 28, (" should be deleted before the word "such".

### *Claim Objections*

4. Claims 1 and 5-8 are objected to because of the following informalities:

At claim 1, "Seed" should read -- A seed --, because a claim should be directed to a single invention.

At claim 5, -- produced -- should be inserted after the word "cells" to clearly indicate that Applicant is claiming subsequent generations of protoplasts or cells in the claimed tissue culture.

At claim 6, the following amendment is suggested as a matter of form; [A] The tissue culture according to claim 5, wherein the cells or protoplasts [of the tissue culture] are [obtained] produced from a plant tissue selected from the group consisting of[.] leaf, pollen, cotyledon, hypocotyl, embryos, root, pod, flower, shoot and stem.

At claim 7, line 1, "and" should be deleted as a matter of form.

At claim 8, line 1, ":" should be deleted as a matter of form.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Freestone (U.S. Patent 5,917,129, published 29 June 1999).

Freestone discloses soybean variety 93B51, having glyphosate resistance, a dull seed coat luster, a brown hilum color, white flower color, tan pod color, tawny plant pubescence color, and in maturity group V (see columns 7 and 8, and Claim 2).

Freestone discloses that soybean variety 93B51 is susceptible to Soybean Cyst Nematode Race 3, while Applicant is silent about susceptibility of the instant invention.

Freestone is silent about the resistance to Frogeye Leaf Spot of soybean variety 93B51.

The % Protein content and % Oil content of soybean variety 93B51 appears to be

proportionally the same as that of the instant invention given the influence of

environmental factors on these two characteristics. Freestone also discloses a soybean

seed, pollen and an ovule from a plant grown from said seed, a tissue culture produced from said plant and a method of producing a hybrid soybean seed using said plant (see claims 1-6 and 10). Hence, Freestone has previously disclosed all of the claim limitations.

Alternatively Freestone teaches soybean variety 93B51, while the instant invention is directed to soybean variety XB32Y04, wherein the instant application does not disclose adequate characteristics of the claimed invention to distinguish soybean variety XB32Y04 from that of the prior art.

The Office does not have the facilities and resources to provide the factual evidence needed in order to establish that the product of the prior art does not possess the same, material, structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is on the Applicant to provide that the claimed product is different from those taught by the prior art and to establish patentable differences. See *In re Best* 562F.2d 1252 USPQ 430 (CCPA 1977) and *Ex parte Gray* 10 USPQ 2d 1922 (PTO Bd. Pat. App. & Int. 1989).

#### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 10 of U.S. Patent No. 5,917,129. Although the conflicting claims are not identical, they are not patentably distinct from each other because Freestone discloses soybean variety 93B51, having glyphosate resistance, a dull seed coat luster, a brown hilum color, white flower color, tan pod color, tawny plant pubescence color, and in maturity group V (see columns 7 and 8, and Claim 2). Freestone teaches that soybean variety 93B51 is susceptible to Soybean Cyst Nematode Race 3, while Applicant is silent about susceptibility of the instant invention. Freestone is silent about the resistance to Frogeye Leaf Spot of soybean variety 93B51. The % Protein content and % Oil content of soybean variety 93B51 appears to be proportionally the same as that of the instant invention given the influence of environmental factors on these two characteristics. Freestone also teaches a soybean seed, pollen and an ovule from a plant grown from said seed, a tissue culture produced from said plant and a method of producing a hybrid soybean seed using said plant (see claims 1-6 and 10). While the instant invention is directed to soybean variety XB32Y04, wherein the instant application does not disclose adequate characteristics of the claimed invention to distinguish soybean variety XB32Y04 from that of Freestone.

***Conclusion***

10. No claims are allowed.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (571) 272-0804. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-0547.

DAVID H. KRUSE, PH.D.  
PATENT EXAMINER



David H. Kruse, Ph.D.  
8 November 2004

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

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